3. Remarks

Presently, claims 18 and 20-23 are pending with claim 18 being in independent form. Claims 1-17 and 19 have been previously cancelled. Claims 18 and 20 have been amended.

35 U.S.C. §102

Claims 18-20 stand rejected under 35 U.S.C. §102(e1) and (e2) as being anticipated by U.S. Patent Appln. Pub. No. 2002/0198147 and USPN 6,642,360, respectively. Applicants filed a §1.131 declaration evidencing Applicants were in possession of SEQ ID NO:2 prior to the earliest effective filing dates of the cited references.

The Examiner states that the declaration "is insufficient to antedate both the '360 patent and the '147 publication because the declaration is directed to the amino acid sequences of SEQ ID NO:2, however, the claims are directed to antibodies to SEQ ID NO:2. It is unclear from the declaration when the claimed antibodies were made. The declaration only provides for the antigen."

The Examiner's basis for rejecting the declaration runs counter to legal precedent. The court in *Noelle v. Lederman* stated:

> "Therefore, based on our past precedent, **as long as an applicant has disclosed a "*fully characterized* antigen,"** either by its structure, formula, chemical name, or physical properties, or by depositing the protein in a public depository, **the applicant can then claim an antibody by its binding affinity to that described antigen.**" (emphasis added, 60 USPQ2d 1541, 1508 (CAFC 2004))

There is no dispute that Applicants discovered and fully disclosed the fully characterized antigen of SEQ ID NO:2 prior to the '360 patent and the '147 publication. Therefore, as permitted under law, Applicants are entitled to claims covering antibodies to that antigen. Applicants' §1.131 declaration shows Applicants were in possession of a fully characterized antigen. Thus, under the current state of law, our declaration disclosing the antigen also supports antibodies to that antigen.

Applicants note that the claims have not been rejected under 102(g) and therefore the issue of when Applicants actually reduced to practice the claimed antibodies has no bearing whatsoever under 102(e).

Should the Examiner maintain his position, he is required to support the rejection with a specific law under USC Title 35, a statute under 37 CFR, and/or a Federal Circuit decision.

35 U.S.C. §112, second paragraph

Claims 21-23 stand rejected under 35 U.S.C. §112, second paragraph as not having proper antecedent basis. Claims 18 and 20 have been amended to specify "An isolated antibody...." Therefore, claims 21-23 have proper antecedent basis. Applicants submit that the present claims, as amended, fully satisfy the requirements of 35 U.S.C. §112, second paragraph and ask that the rejection be withdrawn.

35 U.S.C. §112, first paragraph

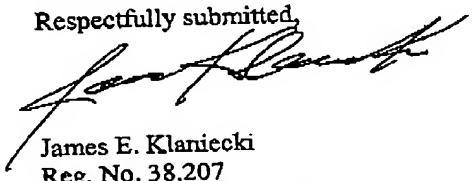
Claims 18 and 20-23 stand rejected under 35 U.S.C. §112, first paragraph (new matter rejection). The Examiner asserts the phrase "the antibody specifically binds to the extracellular domain of SEQ ID NO:2" constitutes new matter. The Examiner also asserts "the specification discloses antibodies to SEQ ID NO:2 but not to the extracellular domain of SEQ ID NO:2".

Applicants disagree and note that "[p]urified LDCAM, a fragment thereof **such as the extracellular domain**.....can be used to generate monoclonal antibodies against LDCAM using conventional techniques....." (page 25, lines 25-28). Applicants also teach that the extracellular domain consists essentially of amino acids 39 to 374 of SEQ ID NO:2 (page 3, lines 28-37).

As such, the subject matter of claim 22 does not constitute new matter and all claims fully satisfy the requirements of 35 U.S.C. §112, second paragraph. Applicants respectfully request that the rejection be withdrawn.

Applicants kindly request reconsideration and allowance of the claims. If any outstanding issues remain that may be easily reconciled, the Examiner is invited to telephone Applicants' representative at the number provided below.

Respectfully submitted,



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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to: Mail Stop Petition, United States Patent and Trademark Office on the date indicated below.

Signed: Nanci M. Kertson Date: April 14, 2006

Nanci M. Kertson